

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 15 and 16 are pending in the application, with claim 15 being an independent claim. Claim 15 is sought to be amended. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 112

Claims 15, 16, and 19 stand rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. More specifically, it is asserted in the Office Action that there is insufficient written description to demonstrate that applicant was in possession of the claimed genus of “variations” of SEQ ID NOs: 33-55 that differ by “no more than 8 nucleotides” or “no more than 2 nucleotides.”

Claim 20 stands rejected under 35 USC § 112, first paragraph, for failing to provide a written description of the claimed invention, i.e., it is asserted in the Office Action that the specification and claims as originally filed to not provide support for the addition of the claim language “and variations thereof that consist of no more than eight additional nucleotides in total appended to either end of the SEQ NOs: 33-55.”

Claims 15, 16, 19, and 20 also stand rejected under 35 USC § 112, first paragraph, for failing to provide enablement for the variations of SEQ ID NOs: 33-55.

In response applicant has canceled claims 19 and 20, and amended claim 15 by deleting the language referring to the variations to the SEQ ID NOs 33-55. Applicant respectfully submits that this amendment places claim 15 in condition for allowance and withdrawal of the rejection of this claim is respectfully requested.

The remaining claim 16 depends directly from independent claim 15 and thus includes the same elements and limitations as claim 15. It is well established in the patent law “that allowance of a parent or base claim as patentable normally results in allowance of a claim dependent upon that claim.” *See DONALD S. CHISUM, CHISUM ON PATENTS* § 7.04[2]; *U.S. v. Telectronics, Inc.*, 658 F. Supp. 579, 591, 3 USPQ2d 1571, 1580 (D. Colo. 1987), *aff’d in part and rev’d in part*, 857 F.2d 778, 8 USPQ2d 1217 (Fed. Cir. 1988), *cert. denied*, 109 S. Ct. 1954 (1989) (“Since it would not have been obvious to have made the invention defined in claim 1, ... it would not have been obvious to make the inventions defined in dependent claims 3, 4 and 5.”); *In re Fine*, 837 F.2d 1071, 1076, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (“Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.”). Applicant submits that claim 16 is allowable and the withdrawal of the rejection of this claim is respectfully requested.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the

Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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Date: 16 April 2009